



Paper No. 18

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OFFICE OF PETITIONS

In re Application of
Tessier-Lavigne et al.
Application No. 09/273,098
Filed: March 19, 1999
Attorney Docket No. UC99-244-2

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ON PETITION

This is a decision on the petition filed August 28, 2001, requesting review under 37 CFR 1.181(a)(3) of the August 22, 2001 decision by a Group Director in Technology Center 1600 (Group Director), which decision refused to withdraw the holding of abandonment in the above-identified application.

The petition under 37 CFR 1.181(a)(3) is **granted**. The holding of abandonment in the above-identified application is **withdrawn**.

BACKGROUND

An Office action was mailed on May 2, 2000. A reply to the Office action was received on September 12, 2000. The reply had a certificate of mailing under 37 CFR 1.8(a) dated Tuesday, September 5, 2000.¹ The response included authorization to charge any necessary extension of time to Deposit Account No. 19-0750.

Petitioner subsequently realized that the reply of September 12, 2000 was not mailed until September 6, 2000. On February 5, 2001, petitioner notified the USPTO of the situation and requested that the USPTO charge Deposit Account No. 19-0750 funds sufficient to pay for a two-month extension of time. On May 25, 2001, petitioner was informed that if the reply was not actually mailed until September 6, 2001, the application was abandoned.

Petitioner filed a petition to withdraw the holding of abandonment on May 25, 2001, which was denied by the Group Director in a decision mailed on August 22, 2001.

¹ September 2, 2000 was a Saturday, and September 4, 2000 was a Federal holiday.

The instant petition requests review of the Group Director's decision of August 22, 2001.

OPINION

37 CFR 1.8(a)(1) provides that:

- (1) Correspondence will be considered as being timely filed if:
 - (i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:
 - (A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or
 - (B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d); and
 - (ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

The correspondence at issue was received or filed in the USPTO on September 12, 2000, as shown by the date of receipt stamped thereon by the USPTO. See 37 CFR 1.6(a). As correctly noted by the Group Director, since petitioner acknowledges that the correspondence filed on September 12, 2000, was not deposited with the U.S. Postal Service on September 5, 2000 (the date indicated on the certificate of mailing), the correspondence filed on September 12, 2000, is not entitled to any benefit under 37 CFR 1.8(a). Specifically, 37 CFR 1.8(a)(1) requires that the correspondence include a certificate for each piece of correspondence stating the date of deposit, and as acknowledged by petitioner the certificate of mailing for the correspondence filed on September 12, 2000, does not state the date of deposit of that correspondence with the U.S. Postal Service. Nevertheless, the correspondence filed on September 12, 2000, was received in the USPTO within five months from the mailing date of the Office action of May 2, 2000 (*i.e.*, within the six-month maximum statutory period for reply set forth in 35 U.S.C. § 133).

While petitioner's (and consequently the USPTO's) recognition of petitioner's lack of compliance with 37 CFR 1.8(a) occurred beyond the six-month maximum statutory period for reply to the Office action of May 2, 2000, the salient points remain that: (1) the USPTO received the correspondence filed on September 12, 2000, within the six-month maximum statutory period for reply; and (2) the correspondence filed on September 12, 2000 contained a petition for any necessary extension of time under 37 CFR 1.136(a)² and an authorization to charge any fees relating to the reply of September 12, 2000 to Deposit Account No. 19-0750. As noted by petitioner, the USPTO routinely accepts fees that, while timely authorized, are not processed

² In addition, 37 CFR 1.136(a)(3) provides, in part, that an authorization to charge all required fees, fees under 37 CFR 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under 37 CFR 1.136(a) for its timely submission.

until well after the expiration the maximum statutory period for reply in the application. Therefore, the USPTO may now charge the fee for a two-month extension of time due for the correspondence filed on September 12, 2000 to Deposit Account No. 19-0750, rendering the correspondence filed on September 12, 2000 a timely reply to the Office action of May 2, 2000.

CONCLUSION

For the above-stated reasons, the petition to withdraw the holding of abandonment in the above-identified application is **granted**. Accordingly, the holding of abandonment in the above-identified application is **withdrawn**.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.

The application file is being forwarded to Technology Center 1600 for further action consistent with this decision.



Stephen G. Kunin
Deputy Commissioner for
Patent Examination Policy